

## REMARKS

### 1. Summary of the Office Action

In the non-final office action mailed October 10, 2008, the Examiner allowed claims 1, 2, 4-8, and 15-20. Applicant respectfully thanks the Examiner for allowing these claims.

The Examiner rejected claims 21-22 and 24-26 under 35 U.S.C. § 101 as being directed toward non-statutory subject matter.

### 2. Status of the Claims

Claims 1, 2, 4-8, 15-22, and 24-26 are pending, with claims 3, 9-15, and 23 having previously been cancelled. Claims 1, 15, and 21 are independent, and the remainder are dependent. In this response, Applicant has amended claims 1, 2, 4-8, 15-18, 21-22, and 24. Unless otherwise discussed below, the claim amendments clarify the language of the claims and are ministerial in nature; and as such, do not introduce new matter.

### 3. Response to the Claim Rejections

**a. Claims 21-22 and 24-26 are directed toward statutory subject matter, as the “means” elements are not properly interpreted as software per se.**

The Examiner rejected claims 21-22 and 24-26 under 35 U.S.C. § 101 as failing as being directed toward non-statutory subject matter. The grounds for the rejection for claim 21 were:

“A system can include both hardware and software embodiments and claim 17 shows that the means for performing the listed steps can be digital logic or software steps. Having a ‘processing means’ only limits the means to those for performing a process and as shown from the specification it is digital logic or software that performs the described process. Software is not considered one of the four statutory classes thus the claim is directed toward non-patentable subject matter.”

Office Action, p. 2.

Applicant respectfully disagrees with the Examiner’s interpretation of claim 21 as being directed to non-statutory subject matter. The proper interpretation of a means plus function claim is to cover the structures (and their equivalents) in the specification that perform the recited functions. “Once a court concludes that a claim limitation is a means-plus-function limitation, two steps of claim construction remain: 1) the court must first identify the function of the limitation; and 2) the court must then look to the specification and identify the corresponding structure for that limitation.” *Ex parte R. Mark Halligan and Richard Weyand*, Board of Patent

Appeals and Interferences, Appeal No. 2008-1588 for U.S. Patent Application No. 09/757,206 (decided November 24, 2008) ("Halligan"), p. 11 (citing *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (Fed. Cir. 2003)).

In the instant application, the specification clearly describes hardware structures, such as a host central processing unit (CPU), baseband processors, RF components, some of which utilize software components to make up a special purpose computer. Thus, the means elements of claim 21 are directed to the structure disclosed in the specification that performs the recited function. In some cases this may cover hardware executing software components to make up a special purpose computer, but not just software alone.

Such an interpretation of means plus functions claims as a special purpose computer programmed to perform a disclosed algorithm does not mean that the means plus function claims are directed to software *per se*. Rather, this interpretation covers the programmed computer as a structure and includes the means and functions disclosed in the specification. Specifically, the Federal Circuit has held that "in a means-plus-function claim in which the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm, the disclosed structure is ... the special purpose computer programmed to perform the disclosed algorithm." *WMS Gaming Inc. v. International Game Tech.*, 184 F.3d 1339, 1348-49, 51 USPQ2d 1385, 1391-92 (Fed. Cir. 1999).

Applicant submits that claim 21, when interpreted in light of the specification, clearly is directed to patentable subject matter. Therefore, for at least the reasons presented above, Applicant respectfully requests the Examiner withdraw the 35 U.S.C. § 101 rejection of pending claims 21-22 and 24-26.

The Applicant submits that the application is in good and proper form for allowance and respectfully request the Examiner to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney, at 312-913-3338.

Respectfully submitted,  
McDONNELL BOEHNEN  
HULBERT & BERGHOFF LLP

Date: February 6, 2009

By: /Thomas J. Loos/  
Thomas J. Loos  
Registration No. 60,161